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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,649	01/26/2004	Ronald Paul Rohrbach	HO1-0010	1181

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Honeywell International Inc.
Law Department, Patent Services
101 Columbia Road
Morristown, NJ 07962

EXAMINER

CINTINS, IVARS C

ART UNIT PAPER NUMBER

1724

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,649

Applicant(s)

ROHRBACH ET AL.

Examiner

Ivars C. Cintins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05 October 2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

The disclosure is objected to because page 1 of the specification improperly refers to this application as "a continuation of Serial No. 09/566,034" (see the insert to line 4 contained in the preliminary amendment filed January 26, 2004). Applicant should note, however, that this application is not a proper "continuation" of Application Serial No. 09/566,034 because it lacks copendency with said prior application. A notice of appeal was filed on September 30, 2003 in Application Serial No. 09/566,034; and since Applicant did not file an appeal brief within 2 months from the date of the notice of appeal, nor did Applicant obtain an extension of time to file this brief, this prior application went abandoned on December 1, 2003. Accordingly, since the instant application was filed on January 26, 2004, it lacks copendency with the prior application which went abandoned on December 1, 2003. Appropriate correction is required.

The amendment filed September 20, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: that pellets made with a diameter in a range of 0.1 to 3 millimeters are preferable to pellets made with a diameter in a range of 0.10 to 5mm (see lines 2-3 of the replacement paragraph for page 8, lines 3-9 of the specification). Applicant should note that although the pellet size range added to the specification via the above noted amendment is supported by original claims 7 and 10, and is therefore not new matter, the newly recited relationship (i.e. less preferable) between this range and the range of 0.1 to 3 millimeters is not suggested by the disclosure originally filed, and is therefore deemed to be new matter. Applicant is required to cancel the new matter in the reply to this Office Action.

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Claims 1-15 are again provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-6, 8-10, 14 and 15 of copending Application Serial No. 09/867,973. As pointed out in the previous Office action, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application do not preclude the presence of an antioxidant in the pellets of the chemically active filter member; and therefore, these claims do not distinguish over claims 2-6, 8-10, 14 and 15 of copending Application Serial No. 09/867,973. Applicant should note that the beneficial additive recited in the claims of said copending application also appears to be present in the recited concentration (see page 10, lines 13-14, of the specification of the copending application).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Applicant's remarks filed September 20, 2004 indicate that a terminal disclaimer will be filed in compliance with 37 CFR 1.321(c) in order to overcome the provisional obviousness-type double patenting rejection contained in this application, and upon receipt of a proper terminal disclaimer, the above noted provisional obviousness-type double patenting rejection will be withdrawn.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Patent Application Publication No. 2002/0014447. Applicant should note that since this application is only entitled to its actual filing date (i.e. January 26, 2004), and not to the filing date of Application Serial No. 09/566,034 (for the reasons given above), Patent Application Publication No. 2002/0014447, having a publication date of February 7, 2002, is deemed to be available as prior art against the claims of this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (571) 272-1155. The

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examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Duane Smith, can be reached at (571) 272-1166.

The centralized facsimile number for the USPTO is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
December 3, 2004